

Application No. 10/678,523  
Amendment dated October 14, 2008  
Office Action mail date: April 14, 2008

**PATENT APPLICATION****REMARKS**

Claims 7, 11-14, 19, 20, 22-25, 29-37, 39-42, 46-53, 70, 74-77, and 82 are pending in the present application. The remainder of claims 1-96 are withdrawn from consideration pursuant to Applicant's Response to the Examiner's Restriction Requirement/Election of Species.

The Examiner has rejected all of the pending claims under 35 U.S.C. § 112, first paragraph. The Examiner also has rejected all of the pending claims under 35 U.S.C. § 112, second paragraph. The Examiner also has rejected claims 20, 22-25, 29-37, 39-42, 46-53, 70, 74-77, and 82 under 35 U.S.C. § 101. The Examiner has rejected claims 7, 11, 13, 20, 22-24, 29-31, 33, 36-37, 39-41, 46-48, 50, 53, 70, 74, and 76 under 35 U.S.C. § 102(a) as anticipated by USP 6,477,552 (Ott '552). The Examiner also has rejected claims 19, 23-24, 35, 40-41, 52, and 82 under 35 U.S.C. § 103(a) as unpatentable over Ott in view of USP 6,697,828 (Ott '828). Applicant respectfully traverses all of these rejections, and requests reconsideration and allowance of the claims in view of the following remarks.

- The § 112 Rejections

Looking first at the § 112, first paragraph rejection, Applicant submits that the present application, while using the term "free bit" most frequently, clearly uses the term interchangeably with the term "empty bit" in several places in the specification. *See, e.g.* paragraphs 3, 55, and 57. Consequently, Applicant submits that the import, to the ordinarily skilled artisan, is that the term "free bit" is synonymous with the term "empty bit," and moreover that the ordinarily skilled artisan would clearly understand that the invention is directed to finding an empty location in a register into which to place a bit.

Because the terms "free bit" and "empty bit" are used interchangeably and/or synonymously in the specification, Applicant submits that the term "free bit" is clearly defined

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and described in the specification so that the ordinarily skilled artisan can make and use the invention. However, in the interest of expediting prosecution, Applicant has replaced the word “free” with the word “empty” throughout the elected claims. Because the terms are interchangeable and/or synonymous, Applicant submits that this amendment has no effect on the scope of the claims. However, Applicant does submit that this amendment should address the rejection under 35 U.S.C. § 112, first paragraph, and accordingly respectfully requests that the Examiner reconsider and withdraw this rejection.

Turning now to the § 112, second paragraph rejection, Applicant respectfully maintains that there is nothing unclear about claim 20. Claim 20 recites an apparatus for performing the method according to claim 7. The Examiner states, “It is unclear whether the claim is an apparatus for a method since the claim cites an apparatus for performing a method”. Applicant believes that this very quote indicates that the claim clearly states what the claims are about. Claim 7 is a method claim; claim 20 recites an apparatus for performing that method. As the Examiner knows, method claims are not, by their terms, limited to being performed by a particular apparatus. That an apparatus is recited for performing a claimed method indicates a particular apparatus for performing that claimed method. Applicant submits that there is nothing indefinite about the apparatus limitations recited in this claim. And there is nothing in the claim that would prevent an ordinarily skilled artisan from understanding what is being claimed, and what would or would not infringe the claim.

However, in order to advance the prosecution of this application, Applicant has amended claim 20 to include language from claim 7. Applicant submits that this amendment does not change the scope of claim 20 at all, since the amendment merely inserts *in haec verba* language that was already in the claim by virtue of its prior recitation. Applicant also has amended claim

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37 correspondingly, and likewise submits that this amendment does not change the scope of claim 37. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the §112, second paragraph, rejection of claims 20, dependent claims 22-25, 29-36, claim 37, .and dependent claims 39-42 and 46-53.

- The § 101 Rejections

Turning now to the § 101 rejection, the foregoing claim amendments, reciting an empty bit rather than a free bit, are discussed for example at paragraphs 3, 55, and 57 of the specification. Applicant discusses an empty bit and a free bit interchangeably in at least these places, in a way that conveys to the ordinarily skilled artisan that what is meant by “free bit in a register” is an empty location in a register. Because Applicant uses the terms “empty” and “free” interchangeably, the clear import is that in the present application, the terms are synonymous. Therefore, Applicant submits that the scope of these claims is unchanged by these amendments.

Moreover, finding an empty bit in a register, as Applicant has discussed earlier in prosecution, clearly is useful, because finding that empty bit provides a location where a bit can be placed without distorting the contents of the register. Therefore, Applicant submits that the claims clearly comply with the requirements of 35 U.S.C. § 101, and accordingly Applicant requests that the rejection be withdrawn as to 7, 11-14, 19, 20, 22-25, 29-37, 39-42, 46-53.

The Examiner has rejected claims 70, 74-77, and 82 based on their recitation of a computer software product. Applicant submits that, at the time these claims were drafted, applicable legal precedent fully supported the status of these claims as compliant with the requirements of 35 U.S.C. § 101. To the extent that the law appears to have changed since then, in the interest of expediting prosecution of the application, Applicant is cancelling these claims.

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- The Prior Art Rejection

Finally, turning to the prior art rejection, Applicant respectfully submits that there is nothing whatsoever in the Ott reference that teaches or even remotely suggests the identification of a next empty bit in a register for any purpose. Assuming for the sake of argument that there are arithmetic operations disclosed in Ott which bear some similarity to one or more of the arithmetic operations disclosed in the present application, nothing in Ott shows or suggests in any way that those arithmetic operations either are for the purpose of, or necessarily inherently result in, finding of a next empty bit in a register. None of the portions of Ott which the Examiner has cited – including portions which show arithmetic operations – disclose or suggest anything whatsoever about finding an empty bit in a register. Instead, Ott relates only to detecting leading zeroes in a number, which Ott calls an operand. *See, e.g.*, Ott ‘552 1:33-36. The operands are 32-bits in length, and are divided into four-bit “nibbles”. *See, e.g.*, Ott ‘552 2:36-40. None of this relates to finding the next empty bit in a register.

The Examiner has failed to cite any particular portion of Ott ‘552 which specifically describes finding a next empty bit in a register. Breaking a check sector into parts does not identify an empty bit in a register. The Ott ‘552 Abstract reference to a zero bit within a nibble is not an identification of an empty bit in a register. Selecting a leading zero part does not identify an empty bit in a register.

Applicant notes that the Examiner does not appear to have cited Ott ‘828, on which the Examiner had relied previously, in this Office Action. In any event, for reasons which Applicant has articulated previously, Ott ‘828 does not supply the above-discussed deficiencies of Ott ‘552.

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**PATENT APPLICATION**

Pursuant to the foregoing, Applicant submits that the claims are patentable over Ott '552, and accordingly Applicant requests that the Examiner reconsider and withdraw the prior art rejection as well.

**Request for Allowance**

It is believed that this Amendment places the application in condition for allowance, and early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

The Office is hereby authorized to charge any fees, or credit any overpayments, to Deposit Account No. **11-0600**.

Respectfully submitted,  
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